

**REMARKS**

Rejection under 35 U.S.C 103

Claim 1-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,174,188 to Petroz and over Petroz in view of Kapocsi. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Petroz in view of U.S. Pat. No. 3,812,748 to Habeck or in view of U.S. Pat. No. 3,812,748 to Nausbaum and claims 6, 7 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petroz in view of published U.S. Patent application No. 2002/056345 to Genser or in view of U.S. Pat. No. 5,974,903 to Shirley. The Applicants respectfully disagree.

Claim 1

The Examiner acknowledges in the Action that Petroz does not expressly teach that the cutter is fixed horizontally selective to the base. Further, in section 2 of the Action, the Examiner states that it would have been obvious to a person of ordinary skill in the art to keep the cutter immobile horizontally and consequently keep the cutter fixed horizontally selective to the base "because converting an adjustable device such as a cutter 40 to an immobile and a non-adjustable device involves only routine skill in the art".

In section 5 of the Action, the Examiner states that it would have been obvious to one of ordinary skill in the art to keep the cutter of Petroz's cutting machine fixed horizontally as taught by Kapocsi, in order to eliminate the horizontal adjusting mechanism of the cutter and decrease the cost of manufacturing the cutting machine. Applicants note that, by citing Kapocsi and by explaining how one of ordinary skill in the art would use Kapocsi to modify Petroz, the Examiner acknowledges that modifying Petroz alone, without the help of any reference, to suppress the horizontal motion, involves more than "routine skill in the art".

Petroz (see Fig. 6) shows a cutting diamond point 40 moved vertically with a platen 44 and moved horizontally with a platen 42, wherein the cutting diamond point 40 forms cleavage paths 50 on semi-conducting substrate.

Kapocsi shows (see Fig. 1) a rotating tool bit 24 disposed on a rotary drive 16 which is fixed horizontally selective to the base. Applicants submit that using in Petroz the rotating tool 24 of Kapocsi would not be proper for "*splitting a test piece*" as recited in claim 1, since a rotating tool would break the test piece. Accordingly, Applicants submit that one skilled in the art would be taught away from combining Petroz and Kapocsi.

The Examiner further notes that in Petroz, "cutter 40 is not the only component of the precise cutting device that is horizontally adjusted. Test piece 26 also has a horizontally adjustment mechanism which adjust the test piece horizontally with respect to the cutter". Applicants note that it has been seen above that replacing the vertically and horizontally mobile tool of Petroz by a tool which is fixed horizontally selective to the base is not a routine operation and is taught away from Kapocsi.

Therefore, Applicants respectfully submit that the obvious solution for one skilled in the art willing to simplify Petroz to decrease its cost would rather be suppressing or simplifying the complex and costly horizontal adjustment mechanism of test piece 26, and keeping the vertically and horizontally mobile tool of Petroz.

Accordingly, Applicants respectfully submit that the Examiner has failed to show that the device for splitting a test piece as recited in claim 1, and in particular comprising "*a cutter disposed on the base under the stage of the microscope and passing through the opening to form notches on the surface of the test piece, wherein said cutter is fixed horizontally selective to said base*" is obvious in view of the cited art. Applicants therefore submit that claim 1 is patentable over the cited art.

#### Claims 2-4

Claims 2-4 depend on claim 1. Applicant submits that claims 2-4 are patentable over Petroz, or over Petroz in view of Kapocsi, at least in view of their dependency on claim 1.

Claim 5

Claim 5 depends on claim 1. The Applicants submit that the Examiner fails to show that either Habeck or Nausbaum disclose or suggest "*a cutter disposed on the base under the stage of the microscope... wherein said cutter is fixed horizontally selective to said base*" as recited in claim 1. In view of the above, the Applicants submit that no combination of Petroz, Kapocsi and either Habeck or Nausbaum would have led to a cutting device as recited in claim 1. The Applicants therefore submit that claim 1 is patentable over Petroz in view of Kapocsi and in view of Habeck, or Nausbaum, and that, at least in view of its dependency claim 5 is patentable over Petroz in view of Habeck or Nausbaum.

Rejection of claims 6, 7 and 13

Claim 6 depends on claim 1 and amended claim 7 depends on claim 6. The Applicants submit that the Examiner fails to show that either Genser or Shirley disclose or suggest "*a cutter disposed on the base under the stage of the microscope... wherein said cutter is fixed horizontally selective to said base*" as recited in claim 1. In view of the above, the Applicants submit that no combination of Petroz, Kapocsi and either Genser or Shirley would have led to a cutting device as recited in claim 1. The Applicants therefore submit that claim 1 is patentable over Petroz in view of Kapocsi and further in view of Genser or Shirley, and that, at least in view of their dependency, claims 6, 7 are patentable over Petroz in view of Kapocsi and further in view of Genser or Shirley.

Prior art made of record and not relied upon

Regarding the prior art made of record by the Examiner but not relied upon, Applicants submit that the Examiner has failed to show that any of the prior art documents made of record disclose or suggest "*a cutter disposed on the base under the stage of the microscope... wherein said cutter is fixed horizontally selective to said base*" as recited in claim 1, and therefore submit that claim 1, as well as dependent claims 2-7 and 13 are patentable over said prior art documents.

\* \* \*

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

July 8, 2005

(Date of Transmission)

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July 8, 2005

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Respectfully submitted,



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